

Application No. 09/240,250
Amendment dated August 7, 2007
Office Action mail date: May 7, 2007

Atty. Docket No. 12988/12
PATENT APPLICATION

REMARKS

Claims 80-83, 85, 87, and 89-96 are pending. By this amendment, Applicant is cancelling claims 84 and 86, and are modifying the dependency of claim 85 to allow for proper antecedent basis.

For the reasons stated herein, Applicant submits that the claims in the present application are patentable.

In the Office Action, Examiner rejected claims 80-86 and 91-92 under 35 U.S.C. §103(a) as unpatentable over Stein (USP 6,246,996) in view of Kuzma (USP 5,771,335) and further in view of Perkowski (US Pub 2002/0004753). The Examiner also rejected claims 87-90 and 93 under 35 U.S.C. §103(a) as unpatentable over Stein in view of Kuzma, and further in view of Wiser (USP 6,385,596). Applicant respectfully traverses these rejections, and requests reconsideration and allowance of the claims in view of the following arguments.

Initially, Applicant respectfully submits that the Examiner did not take into account the claims as amended in the previous responses, and continued to object to language that was changed or removed in a previous amendment. For example, the title was changed in the amendment dated January 25, 2005, but is still objected to in paragraph four of the Examiner's remarks. Applicant also cancelled claim 86, in the last response, yet the Examiner continued to reject it. Most importantly, the storing step in claims 80 and 93 specifies that the consumer does not have to register separately with individual merchants. The Office Action does not address this limitation at all.

As noted in earlier responses, the claims recite the carrying out of electronic transactions over a network, where at least a merchant computer and a consumer information server are involved. The transactions clearly are commercial transactions. The claimed invention is therefore concerned with availability of registration information on the consumer information server. As just mentioned, the invention enables subsequent commercial transactions without the consumer having to separately register purchase information with each individual merchant.

Applicant respectfully requests that the Examiner give proper weight to the claim language that Applicant has used to claim the invention. Once this is done, Applicant submits that the claims clearly are patentable over the prior art of record.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 80, 85, and 91-92

For the reasons detailed below, Applicants submits that, in making this rejection, the Examiner has failed to consider the claimed system as a whole but rather has evaluated select features of the system on their individual merits.

Looking at the prior art, the Stein reference teaches payment, from one entity to another, over a network. The Kuzma reference teaches transmission of electronic mail -- something not even claimed in claim 80 -- and has nothing to do with a consumer transaction. Perkowsky relates to a database of product information based on UPC information, and has nothing to do with storing information to enable subsequent consumer transactions so that the consumer does not have to register separately with respective merchants.

Instead of looking at the actual claim language, the Examiner generalized the invention of claim 80 as "about getting related information before doing an electronic transaction." This description does not consider all the elements of the claim, including the consumer registration process and the storage of consumer information for future use with a plurality of different merchants.

The Examiner indicated that the method of claim 80 has been suggested by Stein and Perkowsky:

Stein et al teach a method for conducting electronic transaction over a network (See Stein et al., Fig.1). In addition, Perkowsky suggests about using a customer information server to provide information to a merchant or another

merchant; obviously a customer must register to submit these customer-related information to that server (see Perkowski, claim 13).

Importantly, the information that Perkowski stores is not consumer information. It has nothing to do with any particular consumer's information. Rather, Perkowski stores consumer product information. This storage does not prevent the customer from having to register separately with each merchant with whom the customer desires to do business.

In paragraph 5A of the Office Action, the Examiner argued that Stein "teaches a structure for all transaction communication between a seller and an Internet server." Applicant submits that this interpretation of Stein is overbroad. Stein, at best, teaches communication between two users, where one user is to pay another user. There is nothing in this reference that suggests storage of registration information at a consumer information server, so that a consumer can use that information to conduct transactions with a plurality of merchants, without having to register with each merchant. The Stein reference is further limited to the sale of an information product deliverable over the Internet and an exchange approved via email communication, with the actual monetary transaction concluded off-line between two account holders on the described payment system. There is no mention of one of these entities being able to conduct transactions with multiple entities without having to re-register with each entity.

Kuzma teaches "a method for transmitting e-mail over a network". Kuzma, col. 1, l. 56. Claim 80 does not include any reference to email communication; therefore Kuzma has nothing to do with the invention of claim 80 and is not applicable to the rejection of this claim.

While the Examiner has reiterated that Kuzma and Stein talk about a "middle man" which might be a server or the Internet, Applicant notes again that claim 80 recites a consumer information server with more specific attributes. "The Internet" does not store information. The Examiner's reference to a "server" is far too generic, for reasons that Applicant has stated before. Servers store information, but Stein and Kuzma do not teach or suggest the combination of

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registration information storage and merchant computer information that the claims of the present application recite.

Perkowsky does not remedy the deficiencies of Stein and Kuzma. Perkowsky describes "a system of finding and serving information pertaining to a particular product on the Internet" using unique product codes or manufacturer trademarks for identification. Perkowsky, claim 1. Applicant submits that Perkowsky organizes product information – not the type of information a consumer would need to register with merchants, which is what claim 80 recites. Perkowsky operates on the Internet using a merchant information server limited in functionality to merchant registration and product information display. Perkowsky does not suggest use with a commercial transaction, nor does the server in Perkowsky solicit registration information from consumers. Perkowsky does not request or store data pertinent to a consumer purchase transaction, other than the merchant's own product information. Again, this is not the type of information that a consumer would need to register with a merchant, let alone with a plurality of merchants.

Even assuming *arguendo* that Stein, Kuzma, and Perkowsky show everything that the Examiner says, other claim elements still are missing. Particularly, nothing in the Examiner's rejection adequately addresses the element of "storing the registration information for use in subsequent consumer transactions so that the consumer does not have to register separately with respective merchants." The Examiner asserts that "buyer's computer often stores or prints out registration information page as evident of an electronic transaction that could be used later." However, this has nothing to do with the storage of registration information by a consumer information server, and the Examiner does not even so allege. Moreover, the Examiner has failed to support the argument with any evidence of specific prior art. For this reason as well, the Examiner has failed to point to specific teachings that clearly suggest every claim limitation.

Additionally, the Examiner has not presented any reason why one skilled in the art would have combined Stein, Kuzma, and Perkowsky in order to piece together the invention as claimed. The Supreme Court, in *KSR International Co. v. Teleflex Inc.*, 550 U.S. __, 14 (2007), indicated that an analysis should indicate "there was an apparent reason to combine the known elements in

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the fashion claimed by the patent at issue.” Without more, the argument appears to be composed of mere conclusory statements reliant on hindsight bias. Therefore, Applicant submits that the Examiner has failed to present a *prima facie* case of obviousness regarding the invention of claim 80.

The rejected dependent claims 85 and 91-92 each contain the limitations of independent claim 80 and should therefore be deemed patentable for at least the same reasons.

Claims 81-83, 87-90 and 93

Regarding claims 81-83, 87-90, and 93, similarly to what Applicant explained above, the method in Stein that teaches communication between two users, where one user is to pay another user, does not suggest every element of the invention of claim 93. Neither Kuzma, nor Wiser, supplies any of the deficiencies of Stein. Kuzma relates to e-mail, but does not disclose or suggest consumer transactions recited in claim 93.

Kuzma teaches “a method for transmitting e-mail over a network” where the email message contains a “reference comprising the network address of an attachment stored locally on a previous node of the network.” Kuzma, col. 1, l. 55-61. The suggested reference in the email is utilized for accessing a remotely stored attachment, not initiating registration or information collection of any kind. The manner in which an email link is used in the method of claim 93 as a whole has been completely disregarded in the Examiner’s rejection.

Wiser teaches “a method for distributing media data files, including audio data to purchasers via a public communications network” utilizing a passphrase for purchaser identification and media encryption which “deters the user from freely copying and distributing” the passphrase and media file to other users. Wiser, col. 8, l. 55. The method for using the passphrase suggested in this disclosure does not address the manner in which the invention of claim 93 utilizes the passphrase for registration purposes, nor does it remedy the deficiencies of Stein and Kuzma in addressing the claimed invention as a whole.

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Even assuming *arguendo* that Stein, Kuzma, and Wiser show everything the Examiner says they show, other elements still are missing. Particularly, nothing in the Examiner's rejection adequately addresses the element for "storing the registration information for use in subsequent consumer transactions so that the consumer does not have to register separately with respective merchants." Furthermore, neither Stein nor Kuzma nor Wiser disclose or suggest "determining whether a consumer is registered with the consumer information server and if the consumer is not registered with the consumer information server, sending a request for registration information" as required by claim 93 and its dependencies.

While the Examiner did not expressly cite a combination of Perkowski and Weisinger (USP 5,778,367) with Stein, Kuzma, and Wiser in this rejection, the Examiner did refer to these references near the end of the Office Action. Applicant has discussed Perkowski's deficiencies earlier. Weisinger is at least as irrelevant as the other four references because it has nothing to do with a consumer-merchant transaction, nor with consumer transactions with a plurality of merchants.

Thus, the Examiner has failed to point to specific teachings that clearly suggest every limitation described in these rejected claims, and therefore has failed to present a *prima facie* case of obviousness.

The rejected dependent claims 87-90 and 81-83 each contain the limitations of independent claim 93 and therefore are patentable for at least the same reasons that claim 93 is patentable.

For the foregoing reasons, Applicant submits that claims 80-83, 85, 87, and 89-93 are patentable. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejections.

Applicant invites the Examiner to contact the undersigned at the telephone number listed below to discuss any matter concerning this application.

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The Office is hereby authorized to charge any fees, or credit any overpayments, to
Deposit Account No. 11-0600.

Respectfully submitted,
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